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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/692,716	10/20/00	DECOSTER	S 05725.0785.0

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EXAMINER

YU, G

ART UNIT	PAPER NUMBER
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1619

DATE MAILED:

10/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/692,716

Applicant(s)

DECOSTER ET AL.

Examiner

Gina C. Yu

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8-8-2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-104 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Receipt is acknowledged of Amendment filed on August 8, 2001. Claims 1-104 are pending. Rejections based on 35 U.S.C. § 112 are withdrawn, and rejections based on 35 U.S.C. § 103 (a) are maintained.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1-18, 21, and 101-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. (EP 0874017) taken with Zviak (The Science of Hair Care, p. 68-70).

Dalle et al. teach a method of making silicone in water emulsions for cosmetic products, wherein the silicone is prepared by blending at least one polysiloxane identical to formula (I) in instant claim 1 and its constituents, at least one organosilicon material that reacts with said polysiloxane by a chain extension reaction, and a metal containing catalyst for said chain extension reaction. See p. 2, line 30 – p. 3, line 36. The emulsion comprises at least one surfactant among anionic, nonionic, amphoteric, and cationic surfactants. The particle size of the silicone copolymer is also in the range of 0.3 – 100  $\mu\text{m}$ , which meets claims 11-12. See p. 5, lines 35-41. In the reference, 9 parts by weight of polysiloxane is used, which meets claims 13, 15, 16 in the instant application. See Examples 1-3 on p. 6. The reference teaches that the invention is applicable to cosmetic products for hair, such as hair shampoo and conditioner, and cosmetics such as mascara. See p. 5, lines 43 – 58. Although the reference suggests adding conventional ingredients including suspending agents and polymers in the composition, the reference lacks a specific mention of using non-cellulose thickener. See p. 6, lines 1-4.

Zviak teaches thickeners for shampoo formulations. See p. 69. The thickeners listed in the reference include natural gums, including karaya, and carboxyvinyl polymers of the Carbopol type, thereby meeting claims 17, 18, and 21.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition in Dalle et al. by adding conventional non-cellulose thickeners in Zviak because of the expectation to have produced hair care compositions with desired viscosity.

(B) Claims 1-19, 20, 22, 24, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dalle et al. in view of Quack et al. (U.S. Pat. No. 4,237,243).

Claims are rejected for the reasons of record.

(C) Claims 1-19, 22, 23, 25-36, and 101-104 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Dalle et al. in view of Mougín et al. (U.S. Pat. No. 6,166,093).

Claims are rejected for the reasons of record.

37 (D) Claims 38-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al., and Mougín et al. as applied to claims 1-19, 22, 23, 25-36, and 101-104 above, and further in view of Restle et al. (U.S. Pat. No. 6,039,936).

Claims are rejected for the reasons of record.

(E) Claims 64-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalle et al. and Mougín et al. as applied to claims 1-19, 22, 23, 25-36, and 101-104 above, and further in view of Decoster et al. (U.S. Pat. No. 6,150,311).

Claims are rejected for the reasons of record.

*Response to Arguments*

Applicant's arguments filed on August 8, 2001 have been fully considered but they are not persuasive.

1. Applicants argue all elements of applicants' claims are neither taught nor suggested.

Particularly, applicants argue that Dalle does not disclose the viscosity of the resulting silicone copolymer product. Dalle teaches the silicone copolymer having viscosity which is greater than  $10^5$  mm<sup>2</sup>/sec, and specifically in the range of  $10^6$  to  $10^8$  mm<sup>2</sup>/sec. See p. 5, lines 35 – 41. Examiner views the viscosity of the instant claims are measured in different unit and does not obviate the obviousness of the disclosed invention unless proven.

2. Applicants argue that there is no motivation to Dalle by combining the thickeners of Zviak, Quack, or Mougin because there is no suggestion in Dalle to alter the viscosity of the composition. Examiner respectfully disagrees. As the applicability of the silicone emulsion of the Dalle in cosmetic compositions varies, one of ordinary skill in the art would have known to add the thickeners of their choice as that the various compositions require different viscosity. Examiner views that the skilled worker would have looked to prior arts such as Zviak, Quack, or Mougin for specific types of thickening agents that are suitable for the specific composition. In this case, for example, the thickeners of Zviak are known as conventional ingredients in shampoo composition, according to the reference. Examiner asserts that employing a known ingredient in the art for the known purposes itself is obvious. Employing the thickeners of Quack for the disclosed cosmetic applications in col. 12, lines 1 – 9, and those of Mougin for mascara composition, would also have been obvious in and of itself.

3. Applicants argue that the obviousness rejections lack “clear and particular” motivation to combine the teachings of the references. Examiner respectfully disagrees. As also cited by

applicant's response, a prima facie case of obviousness requires "*some* suggestion or motivation . . . in the references themselves". See also MPEP § 2144 II (A). Examiner views that the ruling in In re Dembiczak does not change the obviousness analysis set forth in Graham. In fact, citing Rouffet, the court in Dembiczak states that the evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves . . . more often comes from and teaching of the pertinent references." In this case, examiner maintains the position that given the specific purposes and applicability of the thickening agents in Zviak, Quack, and Mougin, a skilled worker would have had clear motivation to combine these teaching with Dalle to formulate the desired specific composition.

4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, the obviousness rejections are based upon the teaching of the thickening agents in cosmetic compositions and the benefits thereof, not on the applicants' disclosure, and thus examiner asserts that the rejections are proper.

5. Applicants argue that Dalle teaches away from the use of cationic surfactants. Examiner respectfully disagrees, as the reference does teach of using cationic surfactants. See p. 4, lines 21 – 37. Given the benefits of the cationic surfactants in Restle et al., one of ordinary skill in the art would have been motivated to combine the teaching of Restle et al. and employ the surfactants.

***Conclusion***


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-305-3593. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu  
Patent Examiner  
October 21, 2001

  
**DIANA DUDASH**  
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